Office-Supreme Court, U.S.
FILED
FEB 24 19
JOHN F. DAVIS, CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1963.

No. 773

GENERAL RADIO COMPANY,
Petitioner,

vs.

THE SUPERIOR ELECTRIC COMPANY,
Respondent.

PETITIONER'S REPLY BRIEF

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Respondent challenges (1) that there is any "conflict" of decisions, (2) that the Third Circuit has overruled the *Eibel Process* test of invention, and (3) that there has been any "reason" over the past dozen years for this Supreme Court to do other than ignore patents and to refuse to hear a *single* patent case involving "the current test of invention".

Is There a Conflict?

What respondent says about the different number of witnesses presented in the District of Columbia and in

the Third Circuit litigation involving the Smiley invention is incorrect and presents a patently false impression.

In the first place, once a patent has been granted, the patentee, under the Patent Act of 1952, 35 U.S.C. 282, is presented with a "presumption" of validity that is much enhanced once a court, as here, has found the invention patentable;[1] and this makes it unnecessary, unless the opposing litigant presents evidence of character that overcomes such presumption, to repeat *all* proofs all over again.

But the fact is that in this Third Circuit litigation, the *complete record* produced by petitioner in the previous District of Columbia litigation—including the cross-examined testimony of all "eleven witnesses who there testified" and the patentee Smiley, himself, was admitted in evidence (DX 5) and thus did not require a second reproduction thereof.

And the further fact is that the only publications[2] relied upon by the Third Circuit as demonstrating anticipation or "obviousness" of invention—*though admittedly not dealing either with petitioner's autotransformers or with coatings for the same "function" as petitioner*—were fully considered and treated with in far greater detail in the District of Columbia litigation.

How can it be said that there is no conflict when the Third Circuit says of Hunt

> This is unmistakably the teaching of Hunt : . . Smiley contributed nothing . . . more than the application of known means . . . even though the use was not theretofore contemplated (A 20).

1. "That the District of Columbia decision enhances the presumption of validity, which arose upon the issuance of the patent, is well-recognized." *Superior Electric Co. v. General Radio Co.*, 194 F. Supp. 339, 343, D.C. N.J., 1961.

2. *Hunt et al.*

and the District of Columbia says of the same Hunt

> Out of context and at first blush, these statements would appear to teach that plaintiff's problem and solution would have been obvious to one skilled in the art. However, . . . Hunt does not deal with autotransformers, copper-to-carbon resistance contacts, nor does Hunt disclose the cause of the burn-out difficulties experienced in the autotransformers. If Mr. Smiley had followed Hunt's teachings . . . he may never have tried these metals for the solution of the very high-temperature burn-out problem (A 9).

And, in the absence of Hunt, even the Third Circuit Court of Appeals itself admitted it would have to reject the infringer's bald oral statement that twenty years earlier it had made the same invention:

> We concede that if the findings rested solely on the testimony of Nelson, there would be a serious question as to the sufficiency of the evidence (A 21).

As to this supposed prior twenty-year old use by the infringer, indeed, the Patent Office itself had held, in refusing to institute public use proceedings, that respondent

> fail(ed) to make out a clear and convincing case of public use or sale, *or even to raise a strong presumption of such use* (D-6, p. 227).

There is, indeed, conflict, and on precisely the same evidence.

And the conflict really arises *on matters of law*; not fact.

Is it invention where the source of a long-standing problem is finally discovered and a remedy supplied, even though the specific remedy had previously been used for different functions, uses or purposes in other kinds of devices with other problems?

The Third Circuit says:

> *assuming that Smiley was the first to discover the cause of the operational difficulties*, the present claim to patentable invention is *not* thereby enhanced . . . *even though its function may be different*, the similarity is sufficient to *negative* patentability . . . this is *not* invention *even though the use was* not theretofore contemplated . . . (A 18-20).

The District of Columbia says:

> "the discovery of the problem . . . *is* patentable . . . while the plating of the contact tracks of each device resolved the difficulty in each . . . there was quite a *difference* in the underlying problem in each . . . (A 7-9).

This is, indeed, conflict of law!

No Overruling of Eibel Process?

Respondent apparently asks this Court to close its eyes to the frank statement of the District Court of New Jersey that it was deliberately not following *Eibel Process* because, though it failed to find

> any later Supreme Court decision expressly overruling that in Eibel . . . more exacting standards for determining patentable invention have been applied by the courts in recent years.

Respondent also asks this Court to close its eyes to the directly conflicting quotations of the courts given on page 7 of the petition herein.

Patent-Busting by the Third Circuit and Patent-Ignoring by the Supreme Court Are of No Public Importance?

Respondent, at the top of page 7 of its brief herein does not dispute petitioner's charge that the Third Circuit Court

of Appeals has, pursuant to its interpretation of the "orders" from the Supreme Court, been

> "destroying . . . all patents coming before it within recent years"

What respondent objects to is that petitioner charges that this "destroying" has been

> *"as a matter of course"*;

respondent preferring to consider that it has been after "careful and thorough study of the record".

But even "careful and thorough study" is of no avail if the "orders" of this Supreme Court are correctly interpreted to be the ultimate destruction of patents.

The respondent's statement that the public has ignored the patent in suit is completely unsupported in the record. That the invention has had tremendous impact all over the world is not disputed (A 6; petition, p. 4).

It is significant that respondent does not dispute, either, that the Supreme Court has refused "to hear every single patent case filed before it, since the passage of the New Patent Act of 1952, that has involved a determination of the current test of invention."

Where the economic life-blood and military security of a nation rest so heavily on invention and innovation—and where we are in an era in which a *single* invention, if created first by a hostile society can mean the loss of our freedom[3]—can it be said not to be in the public interest for this Supreme Court to assist the inventive com-

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3. Has this Court ever considered what would be the American way of life today if Germany or Japan had unlocked the power of the atom first? A single invention!

munity by interpreting and resolving conflict as to the meaning of "invention" in the Patent Act of 1952?

Granting of the petition is decidedly in the public interest.

Respectfully submitted,

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